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10/625,477	07/21/2003	Jack Wiersma	2484U.001	9110

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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/625,477

**Applicant(s)**

WIERSMA ET AL.

**Examiner**

Vickey Ronesi

**Art Unit**

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 25,26,51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/21/03</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-24 and 27-50 in the reply filed on 11/08/2004 is acknowledged.

Claims 25, 26, 51, and 52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/08/2004.

### ***Specification***

2. The disclosure is objected to because on page 8, lines 2-5 applicants have indicated that there are drawings to be examined. No drawings have been filed. Therefore, this portion of the specification should be removed to avoid confusion.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required. Claims 2 and 28 recite that the amount of particles is based on "per gallon of said polyurea" however there is only support in the specification for basis "per gallon of the Side B" (page 14, line 17).

### ***Claim Objections***

4. Claims 3-24 are objected to because the term "protective coating" on line 1 of each claim has antecedent basis in claim 1 and should therefore read as "The protective coating."

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Claims 29-50 are objected to because the term "protective coating" on line 1 of each claim has antecedent basis in claim 27 and should therefore read as "The protective coating."

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-24 and 27-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 27, it is unclear whether the phrase "thereby providing a property of diffuse reflectivity" refers to a coating property or to a microscopic granules property. In the interest of compact prosecution, the examiner has interpreted the phrase as being applied to the coating. It is suggested that the above recited phrase be replaced with "wherein the coating exhibits a property of diffuse reflectivity."

Claims 3 and 4 recite the limitation "said microscopic granules capable of imparting the property of diffuse reflectivity" in lines 2-3 of each claim. There is insufficient antecedent basis for this limitation in these claims.

Claims 2, 5-24 and 28-50 are rejected for being dependent on a rejected claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-16 and 27-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider et al (US 2002/0137872).

Schneider et al discloses a coating composition comprising a liquid film-forming resin such as polyureas (paragraph 0021); 0.1-20 wt % (paragraph 0033) of inorganic particles or mixtures of particles such as borosilicate glass (paragraph 0022) having a particle size ranging from 0.1-15  $\mu\text{m}$  (paragraph 0025) and a spherical shape (paragraph 0027); and pigments (paragraph 0082).

It is noted that although Schneider et al is silent with respect to the property of diffuse reflectivity, it is the examiner's position that since Schneider et al meets the composition limitations, it is inherent that its composition exhibit diffuse reflectivity since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

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In light of the above, it is clear that Schneider et al anticipates the presently cited claims.

7. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Primeaux (US 5,266,671).

Primeaux discloses a polyurea coating (col. 1, line 14) comprising polyurea components, 0-25 wt % based on the amount of polyurea of a filler particle such as glass spheres (col. 6, lines 54 and 67-68), and pigment (col. 7, lines 57-60).

It is noted that although Primeaux is silent with respect to the property of diffuse reflectivity, it is the examiner's position that since Primeaux meets the composition limitations, it is inherent that its composition exhibit diffuse reflectivity since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In light of the above, it is clear that Primeaux anticipates the presently cited claims.

8. Claims 1, 3, 5, 7, 9, 13, 11, 15, 17, 19, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Bradley (US 3,759,852).

Bradley discloses protective coatings comprising glass flakes having a thickness of 0.5-10  $\mu\text{m}$  (col. 3, lines 52-70); an organic type paint liquid such as polyurea (col. 4, lines 31-32); and other additives (col. 4, lines 52-55) such as those exemplified in Example 1, i.e., titanium dioxide pigment and magnesium aluminum silicate (col. 8, lines 46-48).

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It is noted that although Bradley is silent with respect to the property of diffuse reflectivity, it is the examiner's position that since Bradley meets the composition limitations, it is inherent that its composition exhibit diffuse reflectivity since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In light of the above, it is clear that Bradley anticipates the presently cited claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-16 and 27-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (WO 86/05195) in view of ~~the combined teachings~~ of "About Urea" (cited on IDS dated 7/21/2003).

Brooks discloses paint and coating compositions (page 2, lines 2-24) used on roofs (page 5, line 3; page 7, line 9) comprising a hardenable liquid base (page 4, lines 9-12); up to 50 wt % and exemplified amounts of less than 12 wt % (see examples 2-13; pages 6, clm 20) of granular type silica such as borosilicate microspheres (page 3, lines 1-24); and exemplifies the use of titanium dioxide pigment and extenders in examples 5-7 on pages 14-15 in addition to other fillers (see examples 1-14). Although Brooks only discloses the amount of silica based on wt %,

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it is the examiner's position that this range overlap the presently claimed 0.2-0.8 oz/ gallon of polyurea, absent evidence to the contrary.

Although Brooks does not explicitly disclose the use of polyureas, it does teach that the hardenable liquid base can be paint or paint base which will harden (page 4, lines 9-12).

"About Polyurea" teaches the advantages of using polyurea and, in particular, on page 2 teaches that polyurea coatings make an excellent protective covering for roofs due to its fast cure time and insensitivity to moisture.

Given that Brooks is open to the use of any hardenable liquid base in its roof coating composition and given that "About Polyurea" teaches the advantages of using polyurea in protective covering for roofs, it would have been obvious to one of ordinary skill in the art to utilize a polyurea as the liquid base in Brooks and thereby arrive at the presently cited claims.

10. Claims 17-24 and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (WO 86/05195) in view of the combined teachings of "About Urea" (cited on IDS dated 7/21/2003) and further in view of *Hawley's Condensed Chemical Dictionary*.

The discussion set forth in paragraph 9 above with respect to Brooks and "About Urea" are incorporated here by reference.

Brooks discloses in examples 5-7 a coating comprising titanium dioxide and "course [sic] extenders," however, it fails to explicitly disclose any particular extender.

*Hawley's* teaches that sodium magnesium aluminosilicate is commercially available as Hydrex which is a titanium dioxide extender.



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Given that sodium magnesium aluminosilicate is a commercially known titanium dioxide pigment extender, it would have been obvious to one of ordinary skill in the art to utilize sodium magnesium aluminosilicate as one of the coarse extenders in Brooks and thereby arrive at the presently cited claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-8 and 27-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 14, 21, 22, 27, 34, 35, 40, 47, and 48 of copending Application No. 10/880,330. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons give below.

US Appl. '330, like the presently cited claims, discloses a coating composition comprising a polyurea carrier, borosilicate microspheres, and pigment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 10, 2005

vr



  
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